



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,691	12/17/2001	Richard Joseph Caballero	SBL0020US	2964

60975 7590 09/13/2010
CAMPBELL STEPHENSON LLP
11401 CENTURY OAKS TERRACE
BLDG. H, SUITE 250
AUSTIN, TX 78758

EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT	PAPER NUMBER
----------	--------------

3695

MAIL DATE	DELIVERY MODE
-----------	---------------

09/13/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Status

1. Claims 1-35 and 50-63 are pending.

Claims 36-49 are cancelled.

The rejections under 35 USC 101, 112 and 103(a) are maintained for the pending claims.

Responses are provided to Applicant's arguments.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 50-63 are rejected** because the claimed invention is directed to non-statutory subject matter. Independent claim 50 is not directed to any one of the areas of patentable subject matter, such as product, process, process of making or composition.

Claims 51-63 are rejected because of their dependence on independent claim 50.

For a claim to be statutory under 35 USC 101 the following condition must be met:

1) In the claim, the practical application of an algorithm or idea results in a useful, concrete, tangible result.

According to the above guidelines, Applicant's claims are limited to the manipulation of abstract ideas in the context of patentability because the claim lacks an indication of usefulness. The amended independent claims still do not result in an action but merely in a software program which does not meet the requirements of patentable subject matter, such as product, process, process of making or composition under 35 USC 101. Software does not represent a useful, concrete, tangible result under this statute. Software per se is not patent eligible subject matter. In the instant claim only data is transformed. No real object is transformed. Certain steps, critical to the invention, are not claimed, such as the actual processing of an order. The object

language in the claim represent computer programming code language, not a real object. Also, what is presented is the manipulation of data by a software system, so that the use of a processor, the machine, as claimed, is merely trivial to the claimed purpose of the process.

Software is not patentable subject matter. Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory. (MPEP 2106.01, I).

3. Claims 50-63 are rejected because the claimed invention is directed to non-statutory subject matter. Independent claim 50 recites a process comprising of generating, presenting, invoking, receiving and transforming. Dependent claims 51-63 are rejected because of their dependence on independent claim 1. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed

to a different state. Without these elements the invention involves human interaction which is not patentable subject matter.

The machine-or-transformation test is a two-branched inquiry; an applicant may show that a process claim satisfies § 101 either by showing that his claim is tied to a particular machine, or by showing that his claim transforms an article. See Benson, 409 U.S. at 70. Certain considerations are applicable to analysis under either branch. First, as illustrated by Benson and discussed below, the use of a specific machine or transformation of an article must impose meaningful limits on the claim's scope to impart patent-eligibility. See Benson, 409 U.S. at 71-72. Second, the involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity. See Flook, 437 U.S. at 590. (*In re Bilski*, En banc, U.S. Court of Appeals for the Federal Circuit, Washington, DC, Oct. 30, 2008). Per *In re Bilski*, these requirements must be present in each meaningful limitation step and must not merely rely on such limitations in the preamble.

In the instant case, each limitation appears to have equal importance and should therefore have the statutory component. Further, the statutory component must more specifically be a programmed computer or programmed computer processor or server, since simply a processor could mean a human using some kind of processing system or device to perform all of the steps by hand using the computer as a tool to perform all of the claimed tasks. The disclosure appears to have the support for amending independent claim 50 to include a programmed computer processor for complying with the statute.

Please note the Board of Patent Appeals Informative Opinion *Ex parte Langemyer et al*-
http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0

Applicant is advised to avoid new matter in complying with these requirements, and to refer to the locations of support in the specification when making such amendments.

Art Unit: 3695

4. Claims 1-18 and 21-35 are rejected because these dependent claims contain a combination of two or more statutory classes, namely a system and a process/method, and in some cases also an article (a processor) and a computer readable storage medium, thus making these claim statutorily indeterminate. Independent claim 1 contains the conflicting classes of system, storage medium and methods. This makes dependent 2-18 rejected due to their dependence on rejected claim 1. Further, dependent claims 2, 3, 13, 14, 15, 16, 17 and 18 also contain these conflicts of statutory classes.

Dependent claims 21, 22, 23, 24, 25, 26, 27, 28, 29, 30, 31, 32, 33, 34 and 35 are also rejected for containing the same statutory conflicts.

Applicant is advised to satisfy the statutory requirements for the claims. Applicant is also advised not to add any new matter to the specification or the claims.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 51-63 are rejected under 35 U.S.C. 112, first paragraph. Specifically, since the claimed invention is not supported by either a clearly asserted utility or a well established utility for the reasons set forth above in the rejection of the claims under 35 USC 101, one skilled in the art clearly would not know how to use the claimed invention.

6. Claims 1-15 and 50-63 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling.

A clear set of system and method steps leading to the processing of an order, critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

The lack of clarity is based on the conditional logic in the limitations of the independent

claims and the lack of a potential result in a processed order. The dependent claims are rejected due to their dependence on the rejected independent claims.

Ambiguity is caused to a large extent due to the use of programming language instead of standard business language in the specification and in the claims which the ordinary practitioner would use. This is exemplified by the last limitation in claim 50 which recites "transforming at least a portion of the business object into a complex object.". The specification fails to contain a clear definition of the expression " business object" and "complex object ". The preamble leads one to expect that these steps relate to a processed order.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-15 and 50-63 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Evidence that claims 1, 19, 24, 36 and 50 fail to correspond in scope with that which applicant(s) regard as the invention can be found in the specification filed December 17, 2001. In that paper, applicant has stated the invention has the purpose of processing complex orders which include complex services and products, and this statement indicates that the invention is different from what is defined in the claim(s) because the independent claims do not include a limitation which indicates processing of orders. The three conditional choices provide options which do not lead to the processing of an order two out of three of the options.

8. Claims 1-15 and 50-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. For example, the limitation "at least one business service method performs a function associated with the selected option" in independent method claim 50 is vague and indefinite. Independent claims 1, 19 and 36 contain similar enabling limitations (Claim 1 – "the at least one of the plurality of workflow processes is configured to invoke at least one of the plurality of business

service methods to perform a function associated with the selected option.”; Claim 19 – “generate a business object based on the portion of the service profile; and a transformation engine wherein the transformation engine is configured to generate at least a portion of the complex object, and the transformation engine is further configured to perform the generation using the business object.”; Claim 36 – “the means for invoking the workflow process comprises a means for invoking at least one of the plurality of business service methods and the at least one of the plurality of business service methods is configured to perform a function associated with the selected option; means for receiving at least one of a service profile, quote information, and order information pertaining to an account from an external server; means for generating a business object”.

9. Claims 1-15 and 50-63 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are the steps needed to explicitly deliver the result of a processed order as stated in the preambles to the independent claims.

10. Claims 1-15 and 50-63 are rejected under 35 U.S.C. 112, second paragraph, because the metes and bounds in the claims are indefinite. For example, it is unclear what a complex object is and what a business object is. Again, the cause of this problem is because software programming language makes up the content of the claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-35 and 50-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esposito et al. (US Patent 6,587,838 B1) in view of Wiecha (US Patent 5,870,717).

Re. Claims 1 & 50, Esposito discloses a method and system comprising:

- generating a customer portal (CUSTOMER - customer database in a vendor computer – Abstract, ll. 10-13; Col. 3, ll. 20-27 (vendor service offerings and related databases); PORTAL - implicit in Col. 3, ll. 17-20, 28-61. The web page on line 31 makes a portal inherent as explained by Rubin below under Response to Arguments. Since the portal has the purpose of having customers connect through the URL, Esposito discloses or suggests a customer portal).
- a list of products and services (Col. 3, l. 32) associated with an account (Col. 3, ll. 31-43),
- a list of quotes associated with the account (quotes are implicit in Col. 3, ll. 44-46 since transactions are normally completed by making a quote to a customer),
- presenting the customer portal, wherein the customer portal is configured to be displayed on a display coupled to the processor (inherent in Esposito – Col. 3, l. 10 – Col. 4, l. 50),
- the customer portal is presented such that the customer portal is accessible by a user (Col. 3, l. 27), and
- the user is a customer (Col. 3, ll. 28-30, 33-36);
- receiving order information pertaining to an account (Col. 3, ll. 33-36);

Art Unit: 3695

- generating a business object (Fig. 6 is a business object because it has numerous objects related to business – products for sale, etc.); and
- transforming at least a portion of the business object into a complex object (the transformation of Fig. 6 business object and to the complex objects in Fig. 7. The proof of this is based on the evidence represented by the 23 page excerpts from the book “Teach Yourself Visual Basic 4 in 21 days”, Third Edition, are attached to this office action for Applicant’s convenience. This book contains complete instructions for writing every systems and method step claimed in claims 1 and 50. This book provides the evidence of the statement in prior office actions that the claimed limitations were underlying the Esposito and Wiecha disclosures and that the programming technique used in the claimed limitations were well known to the ordinary practitioner of the art at the time of Applicant's invention.

Esposito does not explicitly disclose a workflow process. However, invoking a workflow process is suggested, wherein the workflow process invokes at least one business service method, and the at least one business service method performs a function associated with a selected option from among the plurality of user-selectable options (Esposito suggests a workflow process in Fig. 4, which discloses a computer automated process of business steps in a business transaction process, which is a workflow); Esposito does not explicitly disclose a list of orders associated with the account.

However, Wiecha explicitly discloses

- a workflow process in a computer automated on line process where customers choose products (Fig’s 9 & 10, Col. 2, l. 15, Col. 16, ll. 42-50 – which discloses a workflow process in a buyer’s organization which the ordinary practitioner would have seen as obvious to make use of in a seller’s or intermediary’s system); and the use of object oriented programming in the software for a purchase-sale system (Col. 7, ll. 13-16).
- a list of orders associated with the account (Col. 16, l. 50 – purchase order data base).

Therefore, it would have been obvious to an ordinary practitioner of the art at the time of

Applicant's invention to have combined the disclosures of Esposito, Wiecha and well known practices obvious to the ordinary practitioner based on his own knowledge in order to produce a method and system for processing orders, motivated by a desire to provide real-time notifications to vendors of purchaser requirements in a heterogeneous network environment, and a virtual market place system that incorporates the human element in the purchase and sale transaction (Esposito, Col. 1, ll. 30-34, 60-62).

Re. Claim 51, Esposito does not explicitly disclose updating the status of order line items when a provisioning system completes all or part of an order. However, Wiecha discloses updating the status of order line items when a provisioning system completes all or part of an order.(Col. 17, ll. 4-6 – because the updating in Wiecha implicitly involves the updating of orders, and the core of any order are the line items without which there is no order.).

Re. Claim 52 and 2, Esposito discloses wherein the plurality of business service methods include a Reset Method to delete all saved complex objects from the map (Fig. 7, DELETE. This is deleting the complex objects in Fig. 7, which includes two sections of complex objects, namely Wireless Terminals and Service Regions.).

Re. Claim 19, the disclosures of Esposito and Wiecha are cited in the rejection of claim 1 above. This includes the computer-readable storage medium, the processor, a complex object with order information, a business object and a transformation engine. Esposito also discloses a data manager (inherent).

Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Esposito, Wiecha and well known practices obvious to the ordinary practitioner in order to produce a method, system, apparatus, storage medium and data signal for processing orders, motivated by a desire to provide real-time notifications to vendors of purchaser requirements in a heterogeneous network environment, and a virtual market place system that incorporates the human element in the purchase and sale transaction (Esposito, Col. 1, ll. 30-34, 60-62).

Re. Claims 3-18, 20-35 and 51-63, the rejections of claims 1, 19 and 50 above disclose that Esposito and Wiecha disclose on line computer automated customer service and

Art Unit: 3695

order processing methods and systems. Also cited above is that Esposito and Wiecha disclose the use of the Visual Basic and Java computer programming languages which makes use of object-oriented programming and portals. This suggests the substantial content of dependent claims 3-18, 20-35 and 51-63 as these are mere detailed programming steps using Visual Basic 4 or equivalent programming language for establishing a software driven computer system for order processing and customer service. As already stated on the record. Very sophisticated such systems and methods were sold throughout the United States by Baan, SAB and Oracle using the same exact programming features prior to Applicant's invention. As also stated above, 23 pages of the book "Teach Yourself Visual Basic 4 in 21 days", Third Edition, are attached to this office action for Applicant's convenience. This book contains complete instructions for writing every systems and method step claimed in claims 3-18, 20-35 and 51-63. This book provides the evidence of the statement in prior office actions that the claimed limitations were underlying the Esposito and Wiecha disclosures and that the programming technique used in the claimed limitations were well known to the ordinary practitioner of the art at the time of Applicant's invention.

Therefore, **re. Claims 3-18, 20-35 and 51-63**, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to have combined the disclosures of Esposito, Wiecha and well known practices obvious to the ordinary practitioner in order to produce a method, system, apparatus, storage medium and data signal for processing orders, motivated by a desire to provide real-time notifications to vendors of purchaser requirements in a heterogeneous network environment, and a virtual market place system that incorporates the human element in the purchase and sale transaction (Esposito, Col. 1, ll. 30-34, 60-62).

Response to Arguments

12. Applicant's arguments filed July 6, 2010 with respect to claims 1-35 and 50-63 have been considered but they are not persuasive.

MPEP 2141, II C. Resolving the Level of Ordinary Skill in the Art

Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill. A finding as to the level of ordinary skill may be used as a partial basis for a resolution of the issue of obviousness.

The person of ordinary skill in the art is a hypothetical person who is presumed to have known the relevant art at the time of the invention. Factors that may be considered in determining the level of ordinary skill in the art may include: (1) "type of problems encountered in the art;" (2) "prior art solutions to those problems;" (3) "rapidity with which innovations are made;" (4) "sophistication of the technology; and" (5) "educational level of active workers in the field. In a given case, every factor may not be present, and one or more factors may predominate." *In re GPAC*, 57 F.3d 1573, 1579, 35 USPQ2d 1116, 1121 (Fed. Cir. 1995); *Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc.*, 807 F.2d 955, 962, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986); *Environmental Designs, Ltd. V. Union Oil Co.*, 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983). (underlining added).

"A person of ordinary skill in the art is also a person of ordinary creativity, not an automaton." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1397. "[I]n many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle." *Id.* Office personnel may also take into account "the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* at ___, 82 USPQ2d at 1396.

In addition to the factors above, Office personnel may rely on their own technical expertise to describe the knowledge and skills of a person of ordinary skill in the art. The Federal Circuit has stated that examiners and administrative patent judges on the Board are "persons of scientific competence in the fields in which they work" and that

Art Unit: 3695

their findings are "informed by their scientific knowledge, as to the meaning of prior art references to persons of ordinary skill in the art." *In re Berg* , 320 F.3d 1310, 1315, 65 USPQ2d 2003, 2007 (Fed. Cir. 2003).

IN THE INSTANT CASE: the one of ordinary skill, i.e. the ordinary practitioner, would be a single individual or more likely a team of practitioners. For example, Esposito is a team of two inventors and Wiecha is a single inventor. Further, the Patents and PrePublication database for class 705 - Business Methods demonstrates that inventor teams are composed of as many as 8 inventors. In the typical team found all over American business the team would be working on a project basis as employees of a corporation or would be working together or independently on a consulting basis. One or more team members would in the instant case have the business knowledge of the customer service and purchasing practices. The same or another team member would have been familiar with the automated customer service and enterprise systems which have pervaded American business since at least the 1980's and which have steadily received incremental improvements as computer hardware and software developments have offered steadily improved systems capabilities. The same or other team members would be proficient in workflow process, in computer system design, computer programming and in related computer hardware and computer networks. Such practitioners would have kept up with computer software, hardware and network developments including the internet as recorded in the Microsoft Computer Dictionary and in The Authoritative Dictionary of IEEE Standards Terms, each published annually. This includes the introduction of portals and objects in the mid-1990's (see the definitions in the Response to Arguments section below). For example, regarding the knowledge of the ordinary practitioner in March, 2000, Broadbent et al. (US Patent 6,904,412 B1, hereafter Broadbent) discloses the following: "Those skilled in the art will understand JAVA.TM. programming, Object oriented Programming, and the use of automated "Agents" to perform programmed tasks whenever activated to do so, HTTP, XML and other communications protocols as described in more detail below." (Col. 15, ll. 15, 42-47, 12-47). (underlining added).

Examples of such steadily evolving computer automated software/hardware

combination system suppliers are Computer Associates which had the most successful such system during the 1980's to early 1990's through a product called AskManMan. This system gave way to more sophisticated software systems making use of the rapidly spreading use by programming practitioners of programming languages of html, Java, C++, Visual Basic and others which had efficient features such as portals and objects performing similar functions as claimed which steadily grew throughout the 1990's and since. Such companies as Baan, SAS, and later Oracle, to name just a few of the largest providers of large scale systems and many smaller suppliers of customer service and enterprise systems for smaller companies, equipped suppliers of products and services with these sophisticated computer systems making use of these recently available programming tools. A related series of developments took off in the late 1990's called supply chain systems and related methods which connected customer service and purchasing systems throughout a supply chain. This was facilitated by the application of XML and other developments which enabled the connection of differing software systems to communicate with each other.

The attached sample pages 13, 244 and 671 and the table of contents pages vii - xxiv from the Visual Basic 4 book published in 1995 illustrate the detailed instructions available to systems designers and programmers for how to put together every facet of Applicant's claimed invention. Applicant's inventors surely have this or similar books and manuals from which they learned every detail of the claimed features for building the claimed computer automated methods and systems.

It is in this informed context in which those of ordinary skill would be seeing the obviousness of incorporating the narrow disclosures and suggestions of the prior art cited by the examiner in producing the proper *prima facie* case of obviousness.

ARGUMENT A: “.. The Office Action admits that Esposito fails to teach the construction of the software for processing complex customer inquiries and purchase orders.” (p. 31, ll. 19-20; 19-27).

RESPONSE:

1. Re PORTALS:

Art Unit: 3695

Esposito implicitly teaches and suggests the use of a customer portal as follows:

a) Rubin teaches that "Portals are World Wide Web ("WWW") sites which help users manage and navigate through vast amounts of information stored on the internet. Some well known Internet portals include "Yahoo!.RTM.," Alta Vista.RTM., and Excite.RTM.. Portals typically provide search features which allow users to search for particular types of content by entering keywords. In response to the keyword search request, the portal returns links to relevant Internet sites and/or relevant content stored directly on the portal. For example, if a user enters the keyword "snowboarding," the portal may return a list of hyperlinks to Internet sites related to snowboarding as well as internal portal categories related to snowboarding (e.g., "Recreation>Sports>Snowboarding"). (Rubin et al., US Patent 6,701,522 B1, Col. 1, ll. 9-49; Col. 2, l. 28 - Col. 3, l. 13). This inherently teaches that addresses are used in this network process.

The following is Rubin's more complete disclosure of the knowledge of the ordinary practitioner in April, 2000 regarding portals:

"(2) 1. Field of the Invention

(3) This invention relates generally to the field of network data services. More particularly, the invention relates to an apparatus and method for managing network portal data.

(4) 2. Description of the Related Art

(5) "Portals" are World Wide Web ("WWW") sites which help users manage and navigate through vast amounts of information stored on the Internet. Some well known Internet portals include "Yahoo!.RTM.," Alta Vista.RTM., and Excite.RTM.. Portals typically provide search features which allow users to search for particular types of content by entering keywords. In response to the keyword search request, the portal returns links to relevant Internet sites and/or relevant content stored directly on the portal. For example, if a user enters the keyword "snowboarding," the portal may return a list of hyperlinks to Internet sites related to snowboarding as well as internal portal categories related to snowboarding (e.g., "Recreation>Sports>Snowboarding").

(6) In addition to the keyword search and content management capabilities described above, portals may also provide users with a variety of network applications such as, for example, email, electronic scheduling and contact management, chat groups, newsgroups, personal financing, and instant messaging,

Art Unit: 3695

to name just a few.

(7) Many portals also provide a registration feature which allows users to customize the types of information and/or applications which will be immediately accessible to the user on the portal. For example, the user may configure the portal to automatically retrieve and display information specified by the user such as, for example, the value of the user's stock portfolio, the weather forecast in the user's geographic location, an indication of any unread email messages, the user's appointments for the day, the local news headlines for the day, and/or the television listings for the user's favorite channels that evening.

(8) When the user visits the portal (e.g., via a client computer), he/she may be presented with a single Web page that contains all of the foregoing information, automatically collected and transmitted by the portal. Typically, a portal will transmit a unique Web page and associated data to the user in this manner only after receiving proper authentication (e.g., user ID and password)." (Col. 1, ll. 7-49).

2. Esposito is making use of portals by teaching the use of the internet and related Web pages and various other networks such as Ethernet, LAN, WAN and ATM (Col. 3, ll. 16-20, 30-31).

3. Customer portals are an application which the ordinary practitioner would have seen as implicit in Esposito since Rubin discloses the general knowledge of portals by ordinary practitioners in the Background statement of his invention in April 2000.

4. Re. products and services, orders associated with an account, user-selectable options, please see the above rejections.

ARGUMENT B: No evidence of a workflow process is shown by the examiner (p. 31, l. 28 – p. 32, l. 21).

RESPONSE:

Please see the above rejections.

ARGUMENT C: Discussion of technology (p. 32, l. 22 – p. 33, l. 15).

RESPONSE:

This discussion is unrelated to the claims.

ARGUMENT D: The examiner has used impermissible hindsight reasoning (p. 33, ll. 16-22).

RESPONSE:

Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within level of ordinary skill at time claimed invention was made and **does not include knowledge** gleaned **only from applicant's disclosure**, reconstruction is proper. (*In re McLaughlin*, 170 USPQ 209 (CCPA 1971). (Bolding added).

ARGUMENT E: Improper Support for a motivation to combine. (p. 33, ll. 23-30; p. 34, l. l. 24 - p. 35, l. 12).

RESPONSE:

1) The Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 509 F.2d 566, 184 USPQ 607, (CCPA 1975)

2) There is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

3) ... and references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 9ccpa) 1969.

4) **Guidelines for making a Proper Prima Facie Case of Obviousness** according to the US Supreme Court's *KSR* Decision

a) BASES FOR OBVIOUS REJECTION

(1) Begin with the Graham vs Deere Analysis
Provide Facts.

- A disclosure in a non-analogous art which solves the problem is valid prior art
All elements do not have to be factually demonstrated.

Art Unit: 3695

(2) Valid Non-Factual Analysis – Must explain the differences between the prior art and what one of ordinary skill would have seen as obvious after consideration of the facts according to the following considerations:

- Common Sense
- Obvious to Try
- Expected/Predictable Results
- Expectation of Success
- Design incentives or market forces would have made this improvement obvious
- The state of the art would have made the practitioner recognize the opportunity for improving upon the prior art.
- In re Khan factors – obvious or suggested to one of ordinary skill based on his knowledge – the “inferences and creative steps one of ordinary skill would employ”

(3). ORDINARY SKILL

An examiner may use their personal knowledge to describe the knowledge of one of ordinary skill and what such one would have seen as obvious from the evidence. If the examiner does not explicitly define the one of ordinary skill then the one of ordinary skill is defined by the relevant prior.

(4) FACTORS PROHIBITING A PRIMA FACIE CASE OF OBVIOUSNESS - i.e. ALLOWABILITY

- Unexpected/Unpredictable Results
- Technological barriers to satisfactory combination.
- Factors in the above rationales do not hold up to challenge

b) *In re Kahn*

The guidelines provided by *In re Kahn* as referenced in the US Supreme Court's decision of April 2007 in the case known as KSR, are as follows:

The Court noted that “[t]o facilitate review, this analysis should be made explicit. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006))

(“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the

challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.* at 1741, 82 USPQ2d at 1396.

IN CONCLUSION: The examiner believes that he has made a proper *prima facie* case of obviousness in the rejection of claims 1-35 and 50-63 according the above KSR guidelines. It is important to point out the emphasis made in KSR of their quotation of the above language in *In re Kahn*.. This language emphasizes the importance of considering the phrase “for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ”. The examiner has highlighted this consideration in the rationale of every rejection in making a proper *prima facie* case of obviousness.

ARGUMENT F: No references are cited in the rejection of the dependent claims (p. 34, ll. 1-23).

RESPONSE:

Please see the rejections of claims 2-35 and 51-63 above.

Conclusion

13. Applicant is invited to call the examiner to explore allowable subject matter.

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Charles Kyle, can be reached on (571) 272-6746.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 3695

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington D.C. 20231

or Faxed to (571)273-8300 [Official communications; including After Final communications labeled "Box AF"]

or Faxed to (571) 273-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

September 10, 2010

/Charles R. Kyle/

Supervisory Patent Examiner, Art Unit 3695